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Please find below and/or attached an Office communication concerning this application or proceeding.

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Commissioner for Patents

Examiner's Answer Attached

Sam Rimell
Primary Examiner
Art Unit: 2175

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 18

Application Number: 09/421,139
Filing Date: October 19, 1999
Appellant(s): WILLIAMS ADAMS JR ET AL.

Anne Vachon Dougherty
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 15, 2003.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

No amendment after final has been filed.

(5)   ***Summary of Invention***

The summary of the invention is not considered correct, by reason that it deploys

language specifically identified by the Examiner as being new matter (in particular,

"dynamically generated"). A summary of the invention that does not deploy new matter can be

obtained from the original specification at pages 4-5.

(6)   ***Issues***

The appellant's statement of the issues in the brief are overly generic and do not address

all of the issues raised. The issues on appeal are as follows:

(1) Whether or not claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are properly

rejected under 35 USC 112, first paragraph.

(2) Whether or not claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are properly

rejected under 35 USC 112, second paragraph.

(3) Whether or not claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are properly rejected under 35 USC 102(e) as being anticipated by Mostow et al. (U.S. Patent 5,920,838).

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The groupings of the claims are acceptable, and appellant's arguments will be considered for each one of the groupings.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,920,838   Mostow et al.   Published July 6, 1999   Filed June 2, 1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of the independent claims 1, 7, 21 and 31 have been amended to recite a "dynamic generation" of lesson content. This feature does not appear to exist in the disclosure as originally

filed. In addition, the original disclosure does not anywhere include the word "dynamic" or "dynamically".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of independent claims 1, 7, 21 and 31, the word "dynamic" is indefinite. While the word "dynamic" is itself known, the interpretation and meaning of this word within the context of the invention is unknown, particularly since this word does not appear in the original disclosure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are   rejected under 35

U.S.C. 102(e) as being anticipated by Mostow et al. (U.S. Patent 5,920,838).

Claim 1: FIG. 1 of Mostow et al. discloses user input means (headset 14) which include

an audio input means (microphone) and speech recognition means (20). A user interface (12)

includes audio output means (headphones on headset 14). A program controller means (22)

exists to control the application of a lesson. The lessons are dynamically generated by the

controller means 22 (col 4. lines 22-43, including line 25 in particular) The system further

includes a plurality of distinct databases, collectively referred to as a knowledge base (24). One

such set of databases are lesson databases which provides the stories which the student is

intended to read (stories, novels and libraries recited at col. 5, line 26). Another such set of

databases are the lesson based speech interpretation databases (sets of text segments recited at

col. 5, lines 26-30, and pronunciation database recited at col. 8, lines 45-50).

Claim 2: Col. 5, lines 23-28 recite a database of text segments which include word

fragments. Such fragments can constitute incorrect responses, such as expected

mispronunciations (col. 5, lines 1-12).

Claim 3: Column 8, line 45 recites a database which includes a lexicon of word

pronunciations, which read as a set of correct student responses.

Claim 4: The sound effects recited at col. 5, lines 32-33 read as acoustical information.

Claim 5: The acoustical information relates to the speech processing system.

Claim 6: The computer (12) includes a monitor which serves as a visual output means.

Claim 7: See remarks for claim 1. In addition, the system of Mostow et al. includes a lesson storage database for storing the lesson and the output produced by the student (col. 6, lines 35-44).

Claim 8: The visual output means is the monitor at computer (12). The controller (22) can recall data from the lesson storage database (26) and display this information on the output means.

Claim 9: Column 8, lines 53-54 suggests that the data for a lesson may be imported from a "pre-existing" source. Such a source would necessarily be another computer system from which the data is imported.

Claim 11: The controller (22) monitors the student's progress using a quality control module (col. 9, lines 11-13).

Claim 12: Student progress information is stored at database (26), after it is generated by interaction between the controller (22) and the student.

Claim 13: The controller (22) can alter the level of interaction (col. 4, lines 56-65).

Claim 14: The headset (14) generates audio output.

Claim 16: See remarks for claim 11.

Claim 17: See remarks for claim 12.

Claim 18: See remarks for claim 13.

Claim 19: See remarks for claim 14.

Claim 21: See remarks for claims 1, 2, 3, 4.

Claim 22: Database (26) is a lesson storage database.

Claim 23: The controller (22) monitors student progress using the quality control module (33) and can alter the level of interaction (col. 4, lines 56-65).

Claim 31: See remarks for claim 1.

Claim 32: Information about the student level and student responses can be retrieved from the lesson storage database (26) and can be used to decide which lessons to present (col. 6, lines 35-44).

Claim 33: See remarks for claim 11.

Claim 34: See remarks for claim 12.

Claim 35: See remarks for claim 13.

Claim 36: See remarks for claim 14.

Claim 38: See remarks for claim 7.

Claim 39: See remarks for claim 8.

Claim 44: The database (26) containing stored student responses defines a reading level database.

Claim 45: The system may include a database of story text (col. 5, line 26).

Claim 46: The system may include a database of story pages (col. 5, line 26).

Claim 47: Any database defined in the system of Mostow et al. reads as a session database.

Claim 48: The system allows for replay (The "Back" function, col. 3, line 20).

Claim 49: Any point in the lesson which is started by the controller may be read as the claimed starting point.

Claim 50: A database providing audio output (col 5, lines 32-33) may be used to generate

audio output.

Claim 51: Any text database within the system of Mostow et al. reads as a "text power

set" database.

(11)   Response to Argument

Consideration of Affadavit under 37 CFR 1.131: The rejection of claims 1-9, 11-14, 16-

19, 21-23, 31-36, 38-39 and 44-51 under 35 USC 102(e) are predicated on the Examiner's non-

acceptance of an affidavit submitted November 18, 2002 (paper #10) under 37 CFR 1.131. The

affidavit was followed by a subsequent filing of February 28, 2003 (paper #13). The Examiner's

non-acceptance of the affidavit was by reason that the affidavit submissions (papers #10 and

#13) were incomplete, as they did not comply with the requirements of MPEP 715.07.

In particular, MPEP 715.07 states:

"The affidavit or declaration and exhibits must clearly explain which facts or data

applicant is relying on to show completion of his or her invention prior to a particular date.

Vague and general statements in broad terms about what the exhibits describe, along with a

general assertion that the exhibits describe a reduction to practice amounts essentially to mere

pleading, and thus does not satisfy 37 CFR 1.131(b). See *In re Borowski* 505 F.2d 713, 184

USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out

exactly what facts are established and relied upon by applicant." (emphasis added).

Examiner found that both paper #10 and paper #13 were completely devoid of any

explanation of what the exhibits actually described, beyond their being some type of computer

program. While the examiner was able to ascertain isolated pieces of information from the

commentaries on each individual programming line, examiner found that the affidavit contained no explanations to establish what the computer program actually did or how it related to the actual claimed invention. Examiner found that the affidavit (considering both papers #10 and #13) contained nothing more than the "general assertion" and "mere pleading" outlined in MPEP 715.07. Examiner also found no explanation of the exhibits, much less a clear explanation outlining which facts are established by the affidavit. Given these considerations the affidavit under 37 CFR 1.131 was found to be ineffective in overcoming the rejection under 35 USC 102(e).

Appellant argues that the computer programming instructions are facts being relied upon in support of the affidavit. Examiner agrees that a computer program is a piece of factual evidence, but MPEP 715.07 clearly establishes that appellant must provide more than just an un-explained piece of evidence. In order for the affidavit to be effective, appellant must explain what the evidence actually demonstrates. Lacking such explanation, the Examiner cannot make any real comparison between what is claimed and what is alleged to have been previously invented, and thus cannot positively determine that the affidavit is effective.

Rejection of claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 under 35 USC 112, first paragraph: This issue was raised following the amendment of the original disclosure dated October 19, 1999, paper #6. Applicant amended each of the independent claims 1, 7, 21 and 31 to change the phrase "generating" to "dynamically generating". Examine raised the issue of new matter under 35 USC 112, first paragraph by reason that the term "dynamic" and "dynamically" never appeared at all in the original disclosure. The fact that the term "dynamic" and "dynamically" never appeared in the original disclosure is beyond dispute. A review of the

content of patented parent application (U.S. Patent 6,017,219) shows that these phrases were never used. Appellant has also not provided any citations from the specification showing that these terms were ever used in the original specification. As a result, it is clear that these terms are new in comparison to the content of the original specification.

Given the insertion of new matter, the only question that remains in analyzing this issue is whether or not the newly added content falls into an exception provided in MPEP 2163.07. However, Examiner finds that the phrase "dynamically" is not a mere re-phrasing, as no similar terminology, such as the word "dynamic", previously existed in the disclosure. The word "dynamically" is not a correction of a spelling error because it is an original word that did not previously exist. It is also not an incorporation by reference because it does not refer to any previous documents. The only possibility is that the phrase would be referring to an inherent function, but there is no evidence to support such a conclusion. Appellant presents no arguments that the "dynamic" functionality is an inherent function. While appellant does provide various quotations from the specification at pages 11-12 of the brief, none of the quotations cited actually pertain the actual step of generating a lesson, which is the feature claimed as being "dynamic". If anything, these quotations only confirm the lack of original disclosure for this term.

A further consideration is the fact that the term "dynamic" could be an attempt to claim an artificial intelligence capability that appellant did not originally conceive. Stating that the lessons are "dynamically generated" imples that the processing system actually makes up original stories and original lessons on the spot, rather than simply selecting stories and lessons from an existing knowledge base. As such a capability does not reside in the originally disclosed

system, Examiner further maintains that claims directed to the "dynamic generation" of lesson

content is new matter.

Rejection of claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 under 35 USC 112,

second paragraph:

Appellant does not appear to present any arguments in rebuttal of this rejection. While

appellant does present arguments in rebuttal of the rejection under 35 USC 112, first paragraph,

there is no discussion or rebuttal of the rejection under 35 USC 112, second paragraph.

Accordingly, the rejection is sustained.

Rejection of claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 under 35 USC

102(e) as being anticipated by Mostow et al. (U.S. Patent 5,920,838):

Group I (claims 1, 3, 6, 45-46 and 50): Appellant argues that Mostow et al. does not

disclose the claimed dynamic generation of lesson content. Examiner maintains that the concept

of dynamic generation of lesson content is new matter in the context of the present invention.

Nonetheless, even if it were not determined to be new matter, Mostow et al. discloses this exact

feature. Col. 4, lines 22-43 state that the tutoring function (program controller) is explicitly

described as performing "dynamic" functions (col. 4, line 25) with respect to the generation of

the lesson content for the student. Appellant also argues that the system of Mostow et al. is

nothing more than a "lecture delivery system" (page 14, lines 14-16 of appellant's brief).

However, this argument is clearly erroneous, as the system of Mostow et al. permits student

input via the microphone in headset (14) and a lesson generation functionality that is exactly

described as being "dynamic".

Group II (claims 2, 4, 5, 21, 44, 51): Appellant argues that that Mostow lacks a database of anticipated incorrect student responses. Examiner maintains that the database of text segments (col 4, lines 23-28) reads as a database of anticipated incorrect student responses because this database is used by the tutoring function 22 in correcting incorrect responses. Col. 5, lines 5-12 explicitly state the tutoring function has the capability of detecting incorrect pronunciation of words. The tutoring function derives this capability by relying on the database of text segments. Appellant argues that Mostow et al. lacks a database of acoustical information. However, col. 5, lines 32-33 refer to a records of sound effects within the knowledge base (24). This set of records clearly reads as a database of acoustical information, since effects are in fact acoustical information.

Group III (claims 11-14, 16-19, 23 and 33): Appellant argues that Mostow et al. does not perform evaluation of student's progress. However, examiner maintains that Mostow et al. discloses a quality control module (col. 9, lines 11-15) that makes decisions on whether or not a student has provided acceptable feedback. This module is clearly providing an evaluation of the student's feedback and is making a judgement about whether or not the feedback is acceptable. This is considered to be an evaluation of the student's progress with respect to a particular lesson. Appellant's blanket assertion that the quality control module does not perform an evaluation function fails to consider the disclosed functionality of this module.

Group IV (claims 7-9, 22, 38 and 47-49): Appellant's arguments for this group is that the system of Mostow et al. is merely a "lecture system" and does not disclose a dynamically generated lesson. Examiner maintains that the system of Mostow et al. is not merely "lecture system" as it clearly permits interaction from the student via the microphone in the headset, and

keyboard and mouse inputs at computer (12). Although the term "dynamic generation" of a

lesson is considered to be new matter in the context of the present invention, Mostow et al.

clearly and discloses such dynamic lesson generation at col. 4, lines 22-43, and even invokes the

term "dynamic" at col. 4, line 25.

Group V (claims 31-32, 34-36 and 39): Appellant has not presented any arguments

directed specifically to the claim set in this group. Accordingly, the rejection of these claims are

sustained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
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March 11, 2004

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